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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/314,247	05/18/99	EGGERS	P A-2-6

QM12/1129

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EXAMINER	
COHEN, L	
ART UNIT	**PAPER NUMBER**
3739	8

DATE MAILED: 11/29/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/314,247	Applicant(s) Eggers et al
	Examiner Lee S. Cohen	Group Art Unit 3739

☒ Responsive to communication(s) filed on *Nov 12, 1999* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *80-109* is/are pending in the application.

Of the above, claim(s) *86 and 104* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *80-85, 87-103, and 105-109* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *2,6*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claims 86 and 104 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 7.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 84 and 101 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These limitations relating to a system for smoothing body structures were not originally disclosed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 80-85, 87-103, and 105-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 80 - the return electrode lacks any structural association with the other elements of the system. Claim 81 fails to recite any structural elements. Claim 84 recites only intended use. Claim 91 - "the electrically conductive fluid" and "the patient's body" lack antecedent basis. Claim 92 - "the electrically conductive fluid" lacks antecedent basis. Claim

98 - "the distal surface" lacks antecedent basis. Claim 99 is vague since the voltage source has not been positively claimed as part of the system. Claim 102- the return electrode lacks any structural association with the other elements of the system. Claim 105 - "measuring a temperature at the temperature sensor" is vague. Claim 106 is vague since the power source has not been positively claimed as part of the system and "the electrode terminal" and "the target site" lack antecedent basis. Claim 107 - "the target site" lacks antecedent basis. Claim 108 - "the power supply" lacks antecedent basis. Claim 109 - "the target site" lacks antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 80-82, 85, 87-89, 94, 95, 97, 98, 102, 103, and 107 are rejected under 35 U.S.C. 102(b) as being anticipated by Bales et al (4,682,596). The intended use of the system fails to define over system disclosed by the reference.

Claims 80-83, 85, 87-89, 91, 94, 95, 98, 99, 102, 103, and 105-109 are rejected under 35 U.S.C. 102(e) as being anticipated by Baker (5,514,130). The system of the reference is inherently capable of effecting the intended use.

Claims 80-82, 87-89, 91, 92, 94, 95, 98, 100, 102, and 107 are rejected under 35 U.S.C. 102(e) as being anticipated by Lax et al (5,569,242). The system of the reference is inherently capable of effecting the intended use.

Claims 80-82, 85, 87, 88, 90, 93, 97, 98, 102, and 103 are rejected under 35 U.S.C. 102(e) as being anticipated by Janssen (5,454,809). The intended use of the system fails to define over system disclosed by the reference.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Lax et al. The use of saline for the fluid would have been obvious in light of the teaching of Lax et al.

Claim 96 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of Bales et al, Baker, Lax et al, or Janssen. The particular voltage would have been within the level of skill of the artisan to select to optimize performance of the system.

The disclosure is objected to because of the following informalities: There is no detailed description of Figure 25.

Appropriate correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80-85, 87-103, and 105-109 are rejected under the judicially created doctrine of double patenting over claims 1-59 of U. S. Patent No. 5,697,909 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a similar electrosurgical instrument.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Any inquiry concerning this communication should be directed to Lee S. Cohen at telephone number (703) 308-2998.

Lee Cohen
Primary Examiner